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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/424,431	03/16/2000	JOHN W WONG	287300022USA	7974

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03/08/2005

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EXAMINER

MENDOZA, MICHAEL G

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/424,431	Applicant(s) WONG, JOHN W	
	Examiner Michael G. Mendoza	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 23-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 and 23-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6 December 2004 have been fully considered but they are not persuasive. The applicant argues that Anderson et al. invention is not within the field of endeavor. Anderson et al. teaches a form of radiation therapy, therefore is within the Applicant's field of endeavor. The applicant argues that Anderson et al. does not teach suspending ventilation. Dietz is relied upon for suspension of ventilation. Anderson et al. is used merely for an abort switch for stopping radiation if optimum parameters are not met. The kill switch of Anderson et al. would be fully capable of stopping the any type of radiation.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Human beings and/or human anatomy (mouth) are not statutory subject matter and as such cannot be positively set forth as an element(s) of a claimed combination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15, 29-31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz 5485833 in view of Rienmueller et al. 5067494 in further view of Anderson et al. 6436127.

6. As to claims 15 and 33, Dietz teaches an apparatus for suspending ventilation in a patient and delivering radiation therapy to the patient during suspended ventilation, the apparatus comprising: an apparatus for identifying a specific air flow direction and lung volume of the patient (col. 6, lines 12-16); and an apparatus for administering radiation therapy during the suspension of patient ventilation (col. 2, lines 4-37). It should be noted that Dietz fails to teach an apparatus for suspending patient ventilation.

Rienmueller et al. teaches a device with a common apparatus for suspending patient ventilation (col. 2, lines 12-19 and col. 3, lines 29-51)). Therefore, it would have been obvious to use the apparatus of Rienmueller et al. to assure that substantially no dislocation of organs or of anatomical structure ensues during a measurement or a therapy procedure (col. 2, lines 15-19). It should be further noted that Dietz/Rienmueller fails to teach a first and second operable valve adapted to control inhalation and exhalation of the patient. However it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a first and a second valve, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Furthermore, it is well known in the art or ventilators to use an inhalation and exhalation valve for controlling breathing. It would have been obvious to one having ordinary skill in the art to close any valve creating a flow to be

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closed to completely suspend ventilation. It should be further noted that Dietz/Rienmueller fails to teach an abort switch adapted to halt the apparatus and for administering radiation therapy and open a closed one of the first and second selectively operable valves.

Anderson et al. teaches an apparatus for delivering radiation therapy with a common abort switch (col. 12, lines 3-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the abort switch to allow termination of radiation therapy if the correct parameters are not optimum (col. 13, lines 58-63). Furthermore, Dietz/Rienmueller is fully capable of performing the same function (col. 4, lines 1-5 '494).

7. As to claims 29-31, Dietz/Rienmueller/Anderson fails to specifically teach the use of one-way valves. However, it well known in the art of ventilators to use two one-way valves as evidenced by U.S. Patents 5111809, 5479920, and 6571796. One for inhalation and one for exhalation. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use one-way valve to prevent exhalation into an inhalation part of the apparatus and to prevent inhalation from the exhalation part of the apparatus.

8. Claims 23-26 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz/Rienmueller/Anderson in further view of Beran 4815459.

9. Dietz/Rienmueller/Anderson teaches the apparatus of claims 15 and 33. It should be noted that Dietz/Rienmueller/Anderson fails to teach a t-connector and a second one-way valve.

Beran teaches a device with a t-connector 12 and a second one-way valve (col. 4, line 13), and a pneumotach 50. Therefore it would have been obvious to one having ordinary skill in the art to modify the apparatus of Dietz/Rienmueller/Anderson to include the assembly of Beran to measure air pressure and flow rate of the patient.

10. Dietz/Rienmueller/Anderson/Beran teaches wherein the ventilator assembly comprises a computer 5 and 13 operably associated with the ventilator assembly; a display 6 operably associate with the computer 5.

11. Claim 27, 28, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz/Rienmueller/Anderson as applied to claim 33 above, and further in view of Voss 4752064.

12. Dietz/Rienmueller/Anderson teaches the apparatus of claims 15 and 33. It should be noted that Dietz/Rienmueller/Anderson fails to teach a mirror.

Voss teaches a device with a common mirror for view a patient. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use include the mirror of Voss to allow visualization of the patient when it is not in the normal field of view to gather patient information (col. 3, line 59-col.4, line 4)

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dawson can be reached on (571) 272-4694. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MM


GLENN K. DAWSON
PRIMARY EXAMINER